

REMARKS

At the outset, Applicant notes that the specification has been amended above to correct for a minor clerical informality. No new information has been added, and Applicant respectfully requests entrance of the amendment into the present specification.

As for the present Office Action, the Examiner has first rejected Claims 1-19 of the present invention under 35 U.S.C. §112, second paragraph, based on the contention that those claims, as written, are indefinite. Specifically, the Examiner has stated that the phrase “and the like” in independent claims 1 and 14 is indefinite. Applicant has amended the claims, removing the rejected phrase. Therefore, Applicant submits that all §112 rejections have now been overcome.

Substantively, the Examiner has rejected Claims 1-19 under 35 U.S.C. §§102, 103, as being anticipated by or obvious over one or more of PCT No. WO 91/02831, issued to Glass et al (Glass ‘831), U.S. Patent No. 6,364,793, issued to Valarik (Valarik ‘793), and U.S. Patent No. 5,429,352, issued to Leclerc (Leclerc ‘352). In particular, the Examiner has rejected Claims 1-5 under 35 U.S.C. §102(b) as being anticipated by Glass ‘831, Claims 6-11, and 14-19 under 35 U.S.C. §102(e) as being anticipated by Valarik ‘793, and Claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Valarik ‘793 in view of Leclerc ‘352. Applicant respectfully traverses all such rejections. As will be explained further below, the independent claims of Applicant’s invention, namely claims 1, 14, and 19, define patentable inventions over the cited art, as written, because each of those claims includes at least one element that is not taught, disclosed or suggested by any of the prior art references, either alone or in combination with any other prior art reference.

Claim 1 of the present invention is directed to, among other things, a hockey stick blade having “a molded outer layer defining a rough surface finish.” (Claim 1). The roughened surface is formed by applying a resin to a blade core, and then molding the resin into a single, extended

surface covering the blade core that has at least a portion with a rough surface. The roughened surface increases the friction between the blade and a puck while playing.

Glass '831 does not teach, disclose or suggest such a single, extended surface that is molded into the roughened surface. Instead, Glass '831 discloses a method for hardening the surface of a striking implement, such as a hockey stick, by immersing the implement into an electrolyte with diamond grains (carried on metal-ion carriers), and using electrolytic means to coat those diamond grains onto the surface of the implement. The surface disclosed in Glass '831 is formed from the cumulative effect of a multitude of individual grains, but not from a single, molded outer layer as claimed in the present invention. In fact, Glass '831 teaches away from the use of a molded, roughened outer layer, because incorporating such a layer into an implement already using the individual granular layer of Glass '831 would frustrate the purpose of that reference, as to do so would preempt the use of the individual grains altogether. Thus, Glass '831 does not anticipate or obviate a hockey blade having "a molded outer layer defining a rough surface finish," as claimed in Claim 1.

Similarly, Claim 14 of the present invention is not taught, disclosed or made obvious by the teachings of Valarik '793. Claim 14 is directed to a hockey stick blade or replacement blade, having, among other things, "at least one shock-absorbing element embedded into . . . at least one of [its] outer surfaces." (Claim 14). To "embed" something, one must "make something an integral part of" something else. MERRIAM-WEBSTER COLLEGIATE DICTIONARY ONLINE, *available at* <http://www.webster.com/cgi-bin/dictionary> (last visited Oct. 14, 2002). The way in which the present shock-absorbing elements are "embedded" into the outer surface is clarified in the specification. During the molding process, the shock-absorbing elements are "first inserted into . . . cavities or pockets 36 [in the mold walls], [after which] one or more resin layer[s] . . . is [sic]

applied to each side of the mold.” (Page 6, lines 26-28). Then, the “two-part mold 20 is . . . closed tightly and heated to accelerate the curing of the outer resin layer.” (Page 6, lines 29-30). Thus, the shock-absorbing elements actually become an integral part of the outer layer by being formed into the layer during the formation operation.

The layer disclosed in Valarik ‘793 is applied to a hockey stick having a blade in a number of different ways, including: “as a self-adhesive layer,” (Valarik ‘793, Col. 2, lines 23-24), “by pressure spraying,” (Valarik ‘793, Col. 2, lines 30-31), and by “hot press[ing the] adhesive layer . . .” (Valarik ‘793, Col. 2, lines 35-36). From the examples given in Valarik ‘793, however, it is clear that the adhesive layer disclosed in Valarik ‘793 is not integrally a part of the outer surface of the stick blade. Instead, it is only applied to the surface of the blade using one of the methods described above. Therefore, Valarik ‘793 clearly does not teach or disclose a shock-absorbing element that is “embedded into . . . at least one of [the blade’s] outer surfaces.”

Further, given the disclosure of Valarik ‘793, it would not be obvious to embed the adhesive layer disclosed therein into the outer surface of the blade. In fact, in Valarik ‘793, it appears all of the materials and methods are utilized after the construction of the blade is completed. Thus, Valarik ‘793 actually teaches away from incorporating the adhesive layer integrally into the outer surface of the blade, as all the teachings of that reference are directed to surface application only.

Claim 19 combines the molded outer layer of Claim 1 and the shock absorbing layer of Claim 14 into a single claimed device. Based on the above arguments, Applicant submits that, since the individual elements of Claim 1 and Claim 14 are patentable, the combination of those patentable elements into a single claimed device should similarly be deemed allowable.

As can be seen from the above, none of the references cited by the Examiner, either alone or in combination with any other prior art reference, teach, disclose or suggest the present claims.

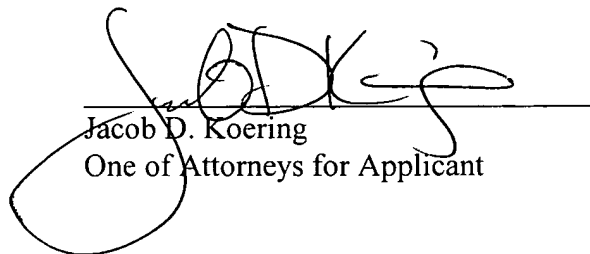
Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1-19. Once the rejections are withdrawn, Applicant submits that the application should be in condition for allowance. Accordingly, reconsideration and passage to allowance of Claims 1-19 is respectfully requested.

Should anything further be required, a telephone call to the undersigned, at (312) 226-1818, is respectfully invited.

Respectfully submitted,

FACTOR & PARTNERS, LLC

Dated: October 14, 2002

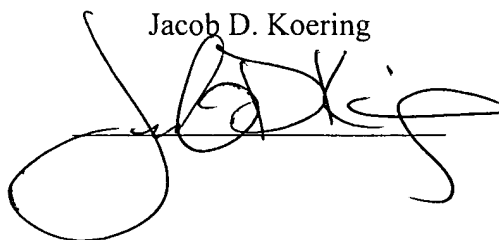


Jacob D. Koering
One of Attorneys for Applicant

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on October 14, 2002.

Jacob D. Koering



AMENDMENTS TO THE SPECIFICATION WITH MARKINGS TO SHOW CHANGES

Please delete the paragraph at Page 5, Line 23, beginning with “Surface 15”, and insert:

- - Surface 15 of blade portion 12 which surrounds shock-absorbing elements 16 is further provided [which] with a rough surface finish adapted to enhance the friction between blade portion 12 and a puck thereby enhancing the gripping of blade portion 12 to the puck and improving the puck handling quality of blade 10. The outer layer is molded to define a rough surface finish on at least a portion of surface 15 of blade portion 12. As best shown in Figures 3 and 3A, preferably, the rough surface finish is a diamond grit texture 31 projecting distance D in the range of 0.005 to 1 mm and preferably about 0.02 to 0.8mm. Advantageously, the diamond grit texture or coarse texture is more pronounced at the heel 32 and toe 34 of blade portion 12 and marginally less pronounced in the midsection of blade portion 12. Diamond grist texture 31 typically projects about 0.05mm at the heel 32 and toe 34 and about 0.025 in the midsection of blade portion 12. Preferably, at least the bottom portion of blade portion 12 includes

diamond grit texture 31 from the ice contacting edge

19 to the middle of blade portion 12, a width of

about 30mm. - -

AMENDMENTS TO THE CLAIMS WITH MARKINGS TO SHOW CHANGES

1. (Once Amended) A hockey stick blade or replacement blade for the game of ice hockey [and the like], said blade comprising:

- a blade portion having two lateral outer surfaces;
- at least one of said outer surfaces having a molded outer layer defining a rough surface finish on at least a portion of said at least one outer surface, said molded outer layer adapted to enhance friction between said blade portion and a puck.

14. (Once Amended) A hockey stick blade or replacement blade for the game of ice hockey [and the like], said blade comprising:

- a blade portion having two lateral outer surfaces;
- at least one of said outer surfaces having at least one shock-absorbing element embedded into said at least one of said outer surfaces.